

REMARKS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and the following remarks are presented for the Examiner's consideration.

Claims 1-4, 7-8, 10, 15-18 and 21-24 were rejected under 35 U.S.C. 103(a) over U.S. Patent No. 5,426,424 to Vanden Heuvel et al. (hereinafter "Vanden Heuvel") in view of U.S. Patent No. 6,259,892 to Helferich (hereinafter "Helferich"). For the following reasons, the rejection is respectfully traversed.

Regarding claims 1 and 15, there is no suggestion or motivation to modify the teachings of Vanden Heuvel based on Helferich. The Examiner states that "Vanden Heuvel et al. suggested the need to modify a time that set by a user to delete old messages in the memory is so desired (column 8, lines 42 to 63)" (see paper no. 5, page 5). The cited passage of Vanden Heuvel does not contain any suggestion of deleting in relation to an elapsed time. Rather, Vanden Heuvel describes a memory addressing system in which references to a database stored in a memory are deleted in a control register (503), thereby eliminating the need to erase the actual data. This in no way suggests the teaching of Helferich or the erasing of messages in response to an elapsed time, as in the present claims. Since there is no motivation or suggestion in the prior art to make the proposed combination, there is no *prima facie* case of obviousness to support a rejection under 35 U.S.C. 103.

Further regarding claims 1 and 15, neither Vanden Heuvel nor Helferich teaches erasing concerned messages if designated character sequences are contained in the stored messages and a predetermined time has lapsed, as required. The Examiner states that this limitation is absent from Vanden Heuvel, and thus relies upon Helferich for teaching the limitation. Helferich teaches "a timer for allowing the user to program the paging transceiver to perform a desired

function on a message at a particular time.” (See column 3, lines 27-41).

However, there is no teaching or suggestion in Helferich to perform the deletion of a message based on the timer *if designated character sequences are contained in the message*, as in the claims. In the present invention, as claimed, if the predetermined time lapses and the designated character sequences are *not* contained in the message, then the message would *not* be deleted. Thus, even if Vanden Heuvel and Helferich were combined, every limitation of the claims would not be taught or suggested by the combination. Therefore, claims 1 and 15, and their dependent claims 2-4 and 16-18, are patentable over the prior art of record.

Regarding claims 7 and 21, there is no suggestion or motivation to modify the teachings of Vanden Heuvel based on Helferich. The Examiner points to a benefit to modifying Vanden Heuvel wherein “erasing after the messages have been checked would improve the memory space of the selective call receiver and delete unimportant message when the user flags the received message,” (see paper no. 5, page 6). Applicant respectfully reminds the Examiner that “The teaching or suggestion to make the claimed combination . . . must [] be found in the prior art, not in applicant’s disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” (See MPEP § 2143). The mere fact the an advantage would result from the combination does not replace the requirement of an actual suggestion or motivation that can be found *in the prior art*. Since there is no motivation or suggestion in the prior art to make the proposed combination, there is no *prima facie* case of obviousness to support a rejection under 35 U.S.C. 103.

Further, regarding claims 7 and 21, neither Vanden Heuvel nor Helferich teaches or suggests erasing the messages not to be stored in a storage area after the messages have been checked when designated character sequences are contained in the received messages, as required. These claims require that certain messages containing designated character sequences are automatically deleted after they have been checked by the user. The Examiner acknowledges

the deficiency of Vanden Heuvel and relies on Helferich for teaching this limitation, citing column 9, lines 58-67, column 11, lines 35-48 and column 14, lines 6 to 23).

Helferich teaches deleting messages on the paging transceiver (100) in response to a user selected erase message function. The disclosure at column 9, lines 58-67 describes an operation whereby the paging transceiver (100) sending an acknowledgment to the system (30) to inform the system (30) that a message has been received. The disclosure at column 11, lines 35-48 describes an operation whereby a message identifier is removed if a message no longer exists in both the system (30) and the paging transceiver (100). This does not relate to deleting a message because it has been read, but rather to deleting a message identifier because the message has been previously deleted by some other operation. The disclosure at column 14, lines 6 to 23 describes that when a erase message function is performed on the paging transceiver (100), the message may be erased only on the paging transceiver (100) or both on the transceiver (100) and the system (30). Nowhere in this disclosure of Helferich does it teach or suggest deleting a message once it is checked by the user. Thus, even if Vanden Heuvel and Helferich were combined, every limitation of the claims would not be taught or suggested by the combination. Therefore, claims 7 and 21, and their respective dependent claims 8, 10, and 22-24, are patentable over the prior art of record.

Claims 5-6, 9, 11-14, 19-20 and 25-29 were rejected under 35 U.S.C. 103(a) over Vanden Heuvel in view of Helferich and in further view of U.S. Patent No. 5,239,679 to Murai (hereinafter "Murai"). For the following reasons, the rejection is respectfully traversed.

For the above-mentioned reasons, neither Vanden Heuvel nor Helferich teaches or suggests every limitation of claims 1, 7, 15 and 21, from which each of the rejected claims respectively depends. Murai does not teach or suggest any of the above-identified deficiencies of Vanden Heuvel and Helferich. Therefore, even if Vanden Heuvel, Helferich and Murai were

combined, every limitation of the claims is not taught or suggested. Thus, claims 5-6, 11-14, 19-20 and 25-29 are patentable over the prior art of record.

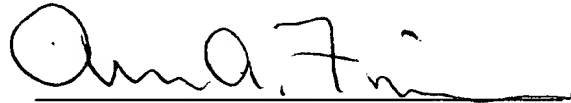
In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 31812.

Respectfully submitted,

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